

REMARKS

Claims 1-9 and 11-20 are pending in this patent application. Reconsideration of the rejections in view of the remarks below is requested.

Claims 1, 6 and 7 were rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter. The rejection is respectfully traversed.

The Office Action states, with respect to claim 1, that “[m]erely performing measurement for a plurality of images of the second test pattern obtained at planes displaced along an optical axis relative to each other would not appear to be sufficient to constitute a tangible result, since the outcome of the performing measurement step has not been used in a disclosed practical application nor made available in such a manner that’s [sic] it’s usefulness in a disclosed practical application can be realized.” The Office Action relies on OG Notices: 22 November 2005, Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility.

Applicant respectfully submits that claim 1 falls within an enumerated statutory category of patentable subject matter. Claim 1 is directed to a practical application and the final result achieved by the claimed invention is “useful, tangible and concrete.” The claimed invention therefore constitutes patentable subject matter.

For example, the Office Action merely refers to the language “wherein the measuring is performed for a plurality of ...” of claim 1. However, this focus ignores entire claim 1, such as portions of the remainder of claim 1 which this “wherein” clause merely characterizes. Specifically, the claim recites the patentable method subject matter of projecting test patterns in a lithographic apparatus, measuring relative displacements and determining information on the aberration of a projection system using the measurements. Thus, the claim recites a patentable method that yields a “useful, tangible and concrete” result, such as information on the aberration of a projection system. The “wherein” language referred to above merely characterizes this patentable method and clearly cannot detract from its patentability as it only further characterizes how it is performed.

The information on the aberration of the projection system has numerous practical applications, several of which are clearly disclosed in Applicant’s specification. For example, the information may be used to apply a correction to improve the imaging. See, e.g., Applicant’s specification, paragraph [0067]. The information could be studied by a user to assess performance of the projection system to decide, for example, on replacement, repair,

etc. of the projection system. The information could be used to improve projection system manufacture so as to meet image quality requirements. See, e.g., Applicant's specification, paragraphs [0003] –[0004]. Other applications also are possible—as one having ordinary skill in the art would readily appreciate after reading Applicant's specification.

Thus, claim 1 is directed to an invention with disclosed practical application and the final result achieved by the claimed invention is “useful, tangible and concrete.”

With respect to claims 6 and 7, the Office Action makes similar rejections to claim 1, in each case focusing on a “wherein” clause. However, as discussed above, this focus ignores the entirety of each of claims 6 and 7, such as portions of the remainder of each such claim which this “wherein” clause merely characterizes. Specifically, these claims recite the patentable method subject matter of projecting test patterns in a lithographic apparatus, measuring relative displacements and determining information on the aberration of a projection system using the measurements. Thus, each claim recites a patentable method that yields a “useful, tangible and concrete” result, such as information on the aberration of a projection system. The “wherein” language referred to above merely characterizes this patentable method and clearly cannot detract from its patentability as it only further characterizes how it is performed.

As discussed above, the information on the aberration of the projection system has numerous practical applications, several of which are clearly disclosed in Applicant's specification. For example, the information may be used to apply a correction to improve the imaging. See, e.g., Applicant's specification, paragraph [0067]. The information could be studied by a user to assess performance of the projection system to decide, for example, on replacement, repair, etc. of the projection system. The information could be used to improve projection system manufacture so as to meet image quality requirements. See, e.g., Applicant's specification, paragraphs [0003] –[0004]. Other applications also are possible—as one having ordinary skill in the art would readily appreciate after reading Applicant's specification.

Therefore, Applicant submits that the rejection under 35 U.S.C. §101 of claims 1, 6 and 7 should be withdrawn.

Applicant notes that the independent claims in this application have not significantly changed since their filing more than 2-1/2 years ago. This rejection clearly could have been and should have been made earlier, the result of raising this rejection at this late juncture being that Applicant loses patent term. Applicant hopes and trusts that the Examiner will not

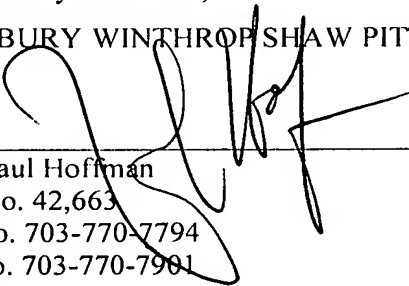
raise any further rejections that could have been raised earlier and cause further loss of patent term.

All rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance. If questions relating to patentability remain, the Examiner is invited to contact the undersigned to discuss them.

Should any fees be due, please charge them to our deposit account no. 03-3975, under our order no. 081468/0308899. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced deposit account.

Respectfully submitted,

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